

Appl. No. 10/657,785
Resp. dtd. Feb. 19, 2009
Resp. to Office action dtd. Sept. 10, 2008

REMARKS

Claims 40-42, 46-51, 55 and 56 were pending in the application at the time of the Office Action.

Claims 55 and 56 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 4,964,121 to Moore ("*Moore*") in view of U.S. Patent No. 4,135,059 to Schmidt ("*Schmidt*").

Claims 40-42 and 46-51 stand allowed.

New dependent claims 57-94, depending from claim 56, have been added by the present amendment.

New dependent claims 95-132, depending from claim 55, have been added by the present amendment.

For at least the reasons stated below, the Applicants respectfully traverse the above rejections and submit that all currently pending claims are allowable.

Examiner Interview

The Applicants would like to thank the Examiner for the interview of Jan. 8, 2009. The Examiner and the Applicants' representative discussed claims 55 and 56 and the *Moore* and *Schmidt* references. In particular, the Examiner and the Applicants' representative discussed clarifying amendments to claims 55 and 56, which would clarify the distinction of such claims from the combination of *Moore* and *Schmidt*. The current amendments to claims 55 and 56 reflect the results of such discussion.

The parties also discussed co-pending applications 09/318,668, 10/630,138 and 10/657,595 and recently issued U.S. Patent No. 7,457,646. The Examiner requested that the Applicants submit terminal disclaimers for such pending applications and issued patent along with a terminal disclaimer to parent patent 5,940,771.

The parties also discussed the ongoing reexamination of U.S. Patent No. 6,374,311 (control no. 90/008,136). Though, as indicated in the Office action mailed Feb. 11, 2008, the Examiner has already considered the references involved in such reexamination, for precautionary reasons, the Examiner expressed an interest in revisiting such references.

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Terminal Disclaimers

As discussed previously, during the above-mentioned Examiner Interview, the Examiner requested that the Applicants submit terminal disclaimers for co-pending applications 09/318,668, 10/630,138 and 10/657,595 and U.S. Patent Nos. 5,940,771 and 7,457,646. Though the Applicants submit that such terminal disclaimers are unnecessary, such terminal disclaimers are submitted herewith to expedite prosecution of the present application.

6,374,311 Reexamination

As discussed previously, during the above-mentioned Examiner Interview, the parties also discussed the ongoing reexamination of U.S. Patent No. 6,374,311 (control no. 90/008,136). Though, as indicated in the Office action mailed Feb. 11, 2008, the Examiner has already considered the references involved in such reexamination, for precautionary reasons, the Examiner expressed an interest in revisiting such references. For the convenience of the Examiner, copies of the Mobitex Terminal Specification and Battery-Saving Addendum are resubmitted herewith as Exhibits 1 and 2. Applicants' submission of the Mobitex Terminal Specification and Battery-Saving Addendum should in no way be construed as an admission or concession by Applicants that such documents constitute or qualify as prior art to the present application. On the contrary, Applicants maintain the position adopted in the ongoing reexam that such documents are not printed publications and reserve the right to assert that position in the future in any forum or proceeding.

Allowed Claims

Claims 40-21 and 46-51 currently stand allowed. This response amends a portion of such claims. The Applicants submit that such amendments should not affect the allowability of the amended claims.

For example, claims 40 and 48 have been amended to remove the "transceiver" element. The Applicants believe that the removal of such element should not affect the allowability of such claims, nor of the claims depending therefrom.

Also for example, claims 46 and 47 have been amended to correct typographical errors, and thus the allowability of such claims should not be impacted by such amendments.

If the Examiner disagrees with the Applicants' position regarding such claim amendments, to advance prosecution in an efficient manner, the Applicants request that the Examiner contact the Applicants' representative to discuss modifications to such claims (*e.g.*, by Examiner amendment).

35 U.S.C. § 103 Rejections

Claims 55 and 56 stand rejected under 35 U.S.C. § 103 as being unpatentable over *Moore* in view of *Schmidt*. Without conceding that *Moore* and/or *Schmidt* qualify as prior art to the present application, the Applicants respectfully traverse such rejections.

As mentioned above, the Applicants' representative and the Examiner discussed claims 55 and 56, along with the *Moore* and *Schmidt* references. In particular, the parties discussed amendments to claims 55 and 56, which would clarify the differentiation of such claims over a *Schmidt*-like TDMA implementation of the *Moore* system. The present amendments to claims 55 and 56 reflect such discussion. Accordingly, the Applicants submit that claims 55 and 56, as currently amended, are allowable over *Moore* and/or *Schmidt*, individually or in reasonable combination, as are all claims depending therefrom, including new claims 57-132.

If the Examiner disagrees with the Applicants' position regarding such claim amendments, to advance prosecution in an efficient manner, the Applicants request that the Examiner contact the Applicants' representative to discuss modifications to such claims (*e.g.*, by Examiner amendment).

New Claims

New dependent claims 57-132 have been added by the present amendment. The Applicants submit that such claims are allowable

Claims 57-94 are system claims that each depend from claim 56 and are thus allowable for at least the reasons for which claim 56 is allowable. The Applicants also submit that each of claims 57-94 is independently allowable.

Claims 95-132 are method claims that each depend from claim 55 and are thus allowable for at least the reasons for which claim 55 is allowable. The Applicants also submit that each of claims 95-132 is independently allowable.

Due to the relatively large number of new claims, for the convenience of the Examiner, the Applicants have provided below a table identifying non-limiting exemplary support for each of the new claims. Also for the Examiner's convenience, since the present application is a continuation of issued U.S. Patent No. 5,940,771, the table below refers to the column and line numbers of the '771 patent.

| Claim | Non-limiting Exemplary Support in 5,940,771 |
|---------|--|
| 57, 95 | Col. 2, lines 26-31 |
| 58, 96 | Col. 23, lines 35-44 |
| 59, 97 | Col. 24, lines 46-48 |
| 60, 98 | Col. 24, lines 53-55 |
| 61, 99 | Col. 30, lines 28-41 |
| 62, 100 | Col. 30, lines 19-23 |
| 63, 101 | Col. 30, lines 19-23 |
| 64, 102 | Col. 34, lines 17-18 |
| 65, 103 | Col. 34, lines 17-18 |
| 66, 104 | Col. 34, lines 17-18; col. 39, lines 17-23 |
| 67, 105 | Col. 34, lines 17-18; col. 39, lines 17-23; col. 39, lines 40-44 |
| 68, 106 | Col. 34, lines 17-18; col. 39, lines 17-23; col. 39, lines 40-44 |
| 69, 107 | Col. 34, lines 17-18; col. 39, lines 17-23; col. 39, lines 40-44 |
| 70, 108 | Col. 34, lines 17-18; col. 39, lines 17-23; col. 39, lines 40-44 |
| 71, 109 | Col. 34, lines 17-18; col. 39, lines 17-23; col. 39, lines 40-44 |
| 72, 110 | Col. 39, lines 17-23; col. 39, lines 40-44 |

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| 73, 111 | Col. 39, lines 17-23; col. 39, lines 40-44 |
| 74, 112 | Col. 34, lines 17-18; col. 39, lines 17-23; col. 39, lines 40-44 |
| 75, 113 | Col. 34, lines 34-35 |
| 76, 114 | Col. 34, lines 39-45 |
| 77, 115 | Col. 34, lines 39-45 |
| 78, 116 | Col. 34, lines 39-45 |
| 79, 117 | Col. 34, lines 11-38; col. 39, lines 40-48 |
| 80, 118 | Col. 34, lines 11-38; col. 39, lines 40-48 |
| 81, 119 | Col. 34, lines 11-38; col. 39, lines 40-48 |
| 82, 120 | Col. 34, lines 11-38; col. 39, lines 40-48 |
| 83, 121 | Col. 39, lines 44-48 |
| 84, 122 | Col. 34, lines 11-38; col. 39, lines 40-48 |
| 85, 123 | Col. 34, lines 11-38; col. 39, lines 40-48; col. 23, lines 35-44 |
| 86, 124 | Col. 38, lines 8-12 |
| 87, 125 | Col. 39, lines 21-23 |
| 88, 126 | Col. 40, lines 3-7 |
| 89, 127 | Col. 41, lines 46-51 |
| 90, 128 | Col. 52, lines 52-58 |
| 91, 129 | Col. 52, line 56 to col. 53, line 2 |
| 92, 130 | Col. 53, lines 37-42 |
| 93, 131 | Col. 53, lines 21-25 |
| 94, 132 | Col. 53, lines 26-30 |

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Final Matters

The Office Action includes various statements regarding the previously pending claims, the *Moore* and *Schmidt* references, one of skill in the art, and 35 U.S.C. § 103, which are now moot in view of the previous amendments and/or comments. Thus, the Applicants will not address all of such statements at the present time. The Applicants neither agree nor disagree with such statements and explicitly reserve the right to challenge any of such statements in the future should the need arise (*e.g.*, if any of such statements are repeated in a future rejection of any claim).

Summary

In summary, the Applicants believe that all pending claims 40-42, 46-51 and 55-132 are in condition for allowance and courteously solicit a Notice of Allowability with respect to all such pending claims. If the Examiner feels that this response does not place the application in condition for allowance, the Applicants invite the Examiner to contact the Applicants' representative to discuss any remaining issues and/or effect any necessary amendments.

The Commissioner is hereby authorized to charge additional fees or credit overpayments to the deposit account of McAndrews, Held & Malloy, Account No. 13-0017.

Dated: Feb. 19, 2009

Respectfully submitted,

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